

NOTES TO THE DEMAND FORM (PCT/IPEA/401)

These Notes are intended to facilitate the filling in of the demand form and to give some information concerning international preliminary examination under Chapter II of the Patent Cooperation Treaty (PCT). For more detailed information, see the **PCT Applicant's Guide**, a publication of WIPO. The Notes are based on the requirements of the PCT, the Regulations and the Administrative Instructions under the PCT. In case of any discrepancy between these Notes and those requirements, the latter are applicable.

In the demand form and these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the Administrative Instructions, respectively.

Please use a typewriter; check-boxes may be marked by hand with dark ink (Rules 11.9(a) and (b) and 11.14).

IMPORTANT GENERAL INFORMATION

Who May File a Demand? (Article 31(2)(a) and Rule 54):

A demand (for international preliminary examination) may only be filed by an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II of the PCT; furthermore, the international application must have been filed with a receiving Office of, or acting for, a State bound by Chapter II. Where there are two or more applicants (for the same or different elected States) at least one of them must qualify.

Where Must the Demand Be Filed? (Article 31(6)(a)):

The demand must be filed with a competent International Preliminary Examining Authority (IPEA). The receiving Office with which the international application was filed will, upon request, give information about the competent IPEA (or see Annex C of Volume I of the PCT Applicant's Guide). If several IPEAs are competent, the applicant has the choice and the demand must be filed with (and the fees must be paid to) the IPEA chosen by the applicant. The IPEA chosen by the applicant may be identified, preferably by an indication of the name or two-letter code of the IPEA, at the top of the first sheet of the demand in the space provided for that purpose.

When Must the Demand Be Filed? (Article 39(1)):

The demand must be filed before the expiration of *19 months from the priority date* in order to extend the time limit for entering the national phase of the PCT procedure from 20 to 30 months from the priority date. *Warning:* if the demand is filed later, the national phase will not be delayed in respect of the elected States and the applicant must enter the national phase before the expiration of the time limit applicable under Article 22 (which is usually 20 months from the priority date).

In Which Language Must the Demand Be Filed?

(Rule 55.1): The demand must be filed in the language of the international application if that language is Chinese, English, French, German, Japanese or Russian; otherwise, the demand must be filed in English.

In Which Language Must Amendments Be Filed?

(Rule 66.9): Amendments and letters relating thereto must be in the language of publication.

What is the Language of Correspondence? (Rule 92.2

and Section 104): Any letter from the applicant to the IPEA must be in the same language as the international application to which it relates. However, the IPEA may authorize the use of another language for letters which do not contain or relate to amendments of the international application. Any letter from the applicant to the International Bureau must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

Which Fees Must Be Paid and When? (Rules 57 and 58):

At the time the demand is submitted, the applicant must pay the preliminary examination fee and the handling fee. The Fee

Calculation Sheet should be used for that purpose. For details concerning the payment of the fees, see the Notes to that Sheet.

BOX No. I

Applicant's or Agent's File Reference: A file reference may be indicated, if desired. It should not exceed 12 characters. Characters in excess of 12 may be disregarded (Section 109).

Identification of the International Application (Rule 53.6):

The international application number must be indicated in Box No. I. Where the demand is filed at a time when the international application number has not yet been notified by the receiving Office, the name of that Office must be indicated instead of the international application number.

International Filing Date and (Earliest) Priority Date

(Section 110): Dates must be indicated by the Arabic number of the day, the name of the month and the Arabic number of the year—in that order; after, below or above such indication, the date should be repeated in parentheses, using two-digit Arabic numerals for each of the number of the day, the number of the month and the last two numbers of the year, in that order, and separated by periods, slants or hyphens, e.g., "05 March 1992 (05.03.92)", "05 March 1992 (05/03/92)" or "05 March 1992 (05-03-92)". Where the international application claims the priority of several earlier applications, the filing date of the earliest application whose priority is claimed must be indicated as the priority date.

Title of the Invention: If a new title has been established by the International Searching Authority, that title must be indicated in Box No. I.

BOX No. II

Applicant(s) (Rule 53.4): All the applicants for the elected States must be indicated in the demand; an applicant named in the request (Form PCT/RO/101) for a State which is not elected need not be named in the demand. It should be noted that the persons named as "inventor only" in the request need not be named in the demand.

Make in Box No. II of the demand the required indications as appearing in Boxes Nos. II and III of the request. The Notes to the request apply *mutatis mutandis*. If there are two or more applicants for the States elected in the demand, give the required indications for each of them; if there are more than three applicants, make the required indications on the "Continuation Sheet".

If different applicants are indicated in the request for different designated States, indicate in Box No. II of the demand only the applicants for the States elected in Box No. V (no indication of the States for which a person is applicant need be made, because those indications have been made in the request).

BOX No. III

Agent or Common Representative (Rules 53.5, 90.1 and 90.2): Mark the applicable check-boxes to indicate *first* whether the person named in this Box is agent or common representative, *then* whether that person *has been appointed earlier* (i.e., during the procedure under Chapter I), or *is appointed in the demand* and any earlier appointment of another person is revoked, or *is appointed specifically for the procedure before the IPEA* (without revocation of any earlier appointment), in addition to the person(s) appointed earlier.

Where an additional person is appointed specifically for the procedure before the IPEA, all notifications issued by the IPEA will be addressed only to that additional person. A separate power of attorney must be filed with the IPEA, the International Bureau or the receiving Office, if the person appointed at the time the demand is filed (i.e., was not appointed earlier) signs the demand on behalf of the applicant (Rule 90.4).

Address for Correspondence (Rule 4.4(d) and Section 108): Where an agent is appointed, any correspondence intended for the applicant will be sent to the address indicated for that agent (or for the first-mentioned agent, if more than one is appointed). Where one of two or more applicants is appointed as common representative, the address indicated for that applicant in Box No. III will be used.

Where no agent or common representative is appointed, any correspondence will be sent to the address, indicated in Box No. II, of the applicant (if only one person is named as applicant) or of the applicant who is considered to be common representative (if there are two or more persons named as applicants). However, if the applicant wishes correspondence to be sent to a different address in such a case, that address may be indicated in Box No. III instead of the designation of an agent or common representative. In this case, and only in this case, the last check-box of Box No. III must be marked (that is, the last check-box must not be marked if either of the check-boxes “agent” or “common representative” in Box No. III has been marked).

BOX No. IV

Statement Concerning Amendments (Rules 53.2(a)(v), 53.9, 62, 66.1 and 69.1): The international preliminary examination will start on the basis of the international application as filed or, if amendments have been filed, as amended. Mark the appropriate check-box(es) to enable the IPEA to determine when and on what basis it can start international preliminary examination.

Mark check-box (i) where the international preliminary examination should start on the basis of the international application as filed.

Mark check-boxes (ii) and/or (iii) where amendments are to be taken into account and submit *with the demand* a copy of amendments to the claims under Article 19 (Rule 53.9(a)(i)) and/or the amendments of the international application under Article 34 (Rule 53.9(c)), as the case may be. If a check-box is marked but the demand is not accompanied by the documents referred to, the start of international preliminary examination will be delayed until the IPEA receives them.

Mark check-box (iv) if amendments of the claims under Article 19 have been filed with the International Bureau during the Chapter I procedure, but the applicant does not want that

these amendments be taken into account for the purpose of international preliminary examination when the latter starts (Rule 53.9(a)(ii)).

Mark check-box (v) where the time limit for filing amendments of the claims under Article 19 has not expired at the time the demand is filed and the applicant wants to keep the option for the filing of such amendments open; the IPEA is thus requested to postpone the start of international preliminary examination (Rules 53.9(b) and 69.1(d)). It should be noted that the examination will start in any event after the expiration of 20 months from the priority date even where the time limit for filing amendments has not yet expired or no amendments have been received by the IPEA.

If no check-box is marked, refer to the footnote at the bottom of Box No. IV.

BOX No. V

Election of States (Rule 53.7): Only States which are bound by Chapter II of the PCT *and* which have been designated in the international application (i.e., States whose designations have been made under Rule 4.9(a), confirmed under Rule 4.9(c) or considered as having been made under Rule 32.2(a)(i)) can be elected. They are the “eligible States.”

For the convenience and protection of applicants, the check-box in Box No. V has been pre-marked so that all eligible States are automatically elected. It is only where the applicant does not wish to elect certain eligible States that the name(s) or country code(s) of those States must be indicated on the dotted line, after the word “except.”

The indication in the demand of the kind of protection or treatment desired for any elected State is not required since it follows the indication made when designating that State in the international application. *Spain* is not eligible because it is not bound by Chapter II and cannot be elected; however, if Spain has been designated in the international application for a European patent together with at least one other Contracting State of the European Patent Convention bound by Chapter II, the time limit under Article 39(1) applies also with respect to Spain if the other State has been elected before the expiration of 19 months from the priority date.

BOX No. VI

Check List: It is recommended that this Box be filled in carefully in order for the IPEA to determine as soon as possible whether it is in possession of the documents on the basis of which the applicant wishes international preliminary examination to start.

BOX No. VII

Signature (Rules 53.8, 90.3(a) and 90.4(a)): The demand must be signed by the applicant or by his agent; if there are two or more applicants, the common representative may sign the demand. If the demand is not signed by (all) the persons who are applicants for the elected States (a person who is applicant only for a State which is not elected need not sign the demand), a power of attorney signed by that (all those) applicant(s) must be filed with the IPEA, with the International Bureau or with the receiving Office unless the agent has previously been appointed.

NOTES TO THE FEE CALCULATION SHEET (ANNEX TO FORM PCT/IPEA/401)

The purpose of the fee calculation sheet is to help the applicant to identify the prescribed fees and to calculate the amounts to be paid. It is strongly recommended that the applicant complete, by entering the appropriate amounts in the boxes provided, and submit the fee calculation sheet at the time of filing of the demand. This will help the International Preliminary Examining Authority (IPEA) to verify the calculations and to identify any error in them.

CALCULATION OF PRESCRIBED FEES

Two fees must be paid for international preliminary examination:

- (i) the preliminary examination fee for the benefit of the IPEA (Rule 58.1);
- (ii) the handling fee for the benefit of the International Bureau (Rule 57).

Both fees must be paid to the IPEA upon filing the demand in a currency acceptable to that Authority.

Information about the amount of those fees or about equivalent amounts in other currencies can be obtained from the IPEA or the receiving Office. This information is also published in Annex E of Volume I of the PCT Applicant's Guide and from time to time in Section IV of the PCT Gazette.

Box P: The amount of the preliminary examination fee must be entered in Box P.

Box H: The amount of the handling fee must be entered in Box H.

Reduction of the Handling Fee for Applicants from Certain States: An applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below 3,000 US dollars (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997) is entitled, in accordance with the Schedule of Fees, to a reduction of 75% of certain PCT fees including the handling fee. If there are several applicants, each must satisfy the above-mentioned criteria. The reduction of the handling fee will be automatically available to any applicant (or applicants) who is (or are) so entitled on the basis of the indications of name, nationality and residence given in Box II of the demand.

The fee reduction will be available even if one or more of the applicants are not from PCT Contracting States, provided that each of them is a national and resident of a State that meets the above-mentioned requirements and that at least one of the applicants is a national or resident of a PCT Contracting State and thus is entitled to file an international application.

Natural persons who are nationals of and reside in the following PCT Contracting States are eligible: Albania, Armenia, Azerbaijan, Belarus, Benin, Bosnia and Herzegovina, Brazil, Bulgaria, Burkina Faso, Cameroon, Central African Republic, Chad, China, Congo, Côte d'Ivoire, Cuba, Czech Republic, Democratic People's Republic of Korea, Estonia, Gabon, Georgia, Guinea, Hungary, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lesotho, Liberia, Lithuania, Madagascar, Malawi, Mali, Mauritania, Mexico, Mongolia, Niger, Poland, Republic of Moldova, Romania, Russian Federation, Saint Lucia, Senegal, Slovakia, Sri Lanka, Sudan, Swaziland, Tajikistan, The former Yugoslav Republic of Macedonia, Togo, Turkey, Turkmenistan, Uganda, Ukraine, Uzbekistan and Viet Nam. As far as other States are concerned, inquiries should be addressed to the International Bureau.

Calculation of the Handling Fee in Case of Fee Reduction: Where the applicant is (or all applicants are) entitled to a reduction of the handling fee, the total to be entered at Box H is 25% of the handling fee.

Total Box: The total of the amounts inserted in Boxes P and H is the amount which must be paid to the IPEA.

MODE OF PAYMENT

In order to help the IPEA identify the mode of payment of the prescribed fees, it is recommended to mark the applicable check-box(es).

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

The applicant should check whether the IPEA allows the use of deposit accounts for payment of PCT fees. In addition, it is recommended that the applicant check what are the specific conditions applicable to the use of deposit accounts with the IPEA since not all IPEAs provide for the same services.

Finally, if the IPEA is not the same national Office or intergovernmental organization as that with which the international application was filed, the deposit account with the receiving Office cannot be charged for the purpose of paying the preliminary examination and handling fees due to the IPEA.

The IPEA will not charge fees to deposit accounts unless the deposit account authorization is signed and indicates the deposit account number.